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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES CLOUGH and DARREL CHERRY

Appeal 2008-2880
Application 09/929,424
Technology Center 2100

Decided:¹ May 8, 2009

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,
JEAN R. HOMERE, and JAMES R. HUGHES, *Administrative Patent*
Judges.

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-36. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

We REVERSE.

Appellants' Invention

Appellants invented a system and method for accessing network-accessible devices such as a network-connected printer. One embodiment of the invention is a system for accessing a network-accessible device configured to wirelessly transmit its associated network address data to one or more client devices, such as a mobile computer, and establish a network connection (link) with the client devices using the associated network address data. The client devices (wirelessly) receive the associated network address data for the network-accessible device and access the network-accessible device through the network using the transmitted associated network address data. (Spec. 3, l. 21 to 4, l. 3; 5, ll. 23-26; 6, ll. 16-20.)²

² We refer to Appellants': Specification ("Spec."); Appeal Brief ("App. Br.") dated May 10, 2007; and Reply Brief ("Reply Br.") dated October 29, 2007. We also refer to the Examiner's Answer ("Ans.") mailed September 11, 2007.

Claims

Independent claims 1 and 21 further illustrate the invention. They read as follows:

1. A system for accessing network-accessible devices comprising:

multiple network-accessible devices, each device comprising:

a wireless transmitter for wirelessly transmitting associated address data for receipt by individual client devices, the address data being configured for use in accessing, via a network, a network-accessible device that wirelessly transmitted the associated address data; and

a connection module for establishing a network link with one or more client devices based upon the wirelessly transmitted address data, said link permitting individual client devices to access a network-accessible device using the associated address data.

21. A method for accessing network-accessible devices comprising:

wirelessly beaconing address data associated with a particular device, the address data being configured for receipt by one or more client devices so that the one or more client devices can use the address data to establish an Internet link with the particular device for interacting with the particular device; and

establishing an Internet link with one or more client devices based on the wirelessly beacons address data, said link permitting interaction between the particular device and the one or more client devices.

Reference

The Examiner relies on the following references as evidence of unpatentability:

Krishnan	US 2002/0103875 A1	Aug. 1, 2002
		(Filed Jan. 26, 2001)

Rejections

The Examiner rejects claims 1-36 under 35 U.S.C. § 102(e) as being unpatentable over Krishnan.

Appellants' Contentions

Appellants contend that the Examiner improperly rejected the claims. Specifically, Appellants contend that Krishnan does not disclose: (1) a network-accessible device wirelessly transmitting associated address data useable by a client device in accessing the network-accessible device through a network (as recited in claims 1-13) (App. Br. 9, 10, 11, and 12); (2) a client device receiving associated address data transmitted by an Internet-accessible device and using the associated address data to access the Internet-accessible device through the Internet (as recited in claims 14-20 and 29-36) (App. Br. 12-13, 14, and 15); or (3) wirelessly beaconing address data of an Internet-accessible device for use by a client device in accessing the Internet-accessible device through the Internet (as recited in claims 21-28). (App. Br. 13 and 14.)

Examiner's Findings and Conclusions

The Examiner found that Krishnan discloses each feature of Appellants' claimed invention. Specifically, the Examiner found that Krishnan discloses a network-accessible device including a wireless transmitter wirelessly transmitting associated address data for receipt by client devices and configured for use in accessing, via a network, a network-accessible device that wirelessly transmitted the associated address data, as well as a connection module establishing a network link with one or more client devices using wirelessly transmitted associated address data. The Examiner found the network link may comprise a wireless link, a wired link, or an Internet link. The Examiner also found that the network accessible device may be an Internet-connected printer, and the transmitter may be a Bluetooth transmitter. (Ans. 4-5.)

ISSUE

Did Appellants establish that the Examiner erred in determining that Krishnan discloses each feature of Appellants' invention, in particular, wirelessly transmitting address data to a client device – the address data associated with a network-accessible device and useable by the client device to access the network-accessible device through a network?

FINDINGS OF FACT (FF)

The following findings of fact relevant to the rejections under review are made based on a preponderance of evidence in the record:

Appellants' Invention

1. Appellants invented a system and method for accessing network-accessible devices including a network-connected printer. (Spec. 3, ll. 21-24 and 6, ll. 16-20.)

2. One embodiment of Appellants' invention is a system for accessing network-accessible devices each comprising a wireless transmitter wirelessly transmitting associated address data useable by client devices to access the network-accessible device (that wirelessly transmitted the associated address data) through a network, and a connection module establishing a network link with the client devices and the network-accessible device using the wirelessly transmitted associated address data. (Spec. 3, ll. 22-26; 6, ll. 24-26; 7, ll. 3-6, 13-24; Figs. 4 and 5.)

Admitted Prior Art

3. Appellants describe typical prior art systems that include numerous networked (network-accessible) devices (printers, plotters, scanners, etc.) that can be accessed by client devices through a network. (Spec. 1, l. 9 to 2, l. 16; Figs. 1 and 2.)

4. Appellants describe that it is known to use both hard-wired and wireless methods (such as Bluetooth) to connect network-accessible devices and client devices to a network. (Spec. 1, ll. 16-19; 5, ll. 6-10; 6, l. 26 to 7, l. 2.)

5. Appellants describe numerous prior art wireless devices that may access a network wirelessly, for example, portable (laptop) computers and personal digital assistants (PDAs). (Spec. 2, ll. 7-8; 5, ll. 23-26.)

6. We note that it is well known in the art of portable computing, as well as network design, to use portable client devices to wirelessly access a network, such as the Internet, and to use portable client devices to access network-accessible devices, such as servers.

Krishnan Reference

7. Krishnan describes an apparatus and method for remote access and operation of an Internet media delivery apparatus (“Internet appliance”). (¶ [0002].)

8. Krishnan describes well known Internet appliances – for example, an Internet radio (delivering audio broadcasts). These appliances access Internet media content through the Internet using the “web” or Internet address (URL) of web site providing media content (e.g., a radio station) from a media server. A computing device may access the Internet appliances through an interface (browser) and the Internet. (¶¶ [0004] to [0009].)

9. Krishnan describes an Internet appliance remote operator that wirelessly sends web addresses (URLs) to an Internet appliance and receives URLs from an Internet appliance. The remote operator remotely controls the Internet appliance allowing a user to access (“tune” the appliance to) different web sites (media servers) or Internet-connected devices. (¶¶ [0010]-[0014] and [0021]-[0023].)

10. Krishnan describes Internet appliances that include a wireless URL (address) beacon and a wireless URL receiver for sending and receiving URL data respectively. (¶¶ [0023] and [0029]-[0033].)

11. Krishnan describes that the Internet appliances also include an engine for utilizing the media content delivered to the appliance and a request module for establishing a connection with the desired Internet (web) site. (¶¶ [0029]-[0031].)

12. Krishnan describes that an Internet appliance can be any Internet-connected device containing web client software (for accessing the Internet), including an Internet radio appliance, an Internet video appliance, an Internet-enabled cell phone, or Internet-enabled office equipment (e.g., a printer, a copier, or a video projector). (¶ [0024].)

PRINCIPLES OF LAW

Burden on Appeal

The Examiner “bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability.” *In*

re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). The Examiner must produce evidence sufficient to support a ruling of unpatentability in the first instance. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

Anticipation

Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Anticipation is determined by first construing the claims and then comparing the properly construed claims to the prior art. *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1346 (Fed. Cir. 2002). We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims "their broadest reasonable interpretation consistent with the specification" and "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Under 35 U.S.C. § 102, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987); *see Perricone*

v. Medicis Pharm. Corp., 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted). However,

[t]he law of anticipation does not require that the reference ‘teach’ what the subject patent teaches. Assuming that a reference is properly ‘prior art,’ it is only necessary that the claims under attack, as construed by the court, ‘read on’ something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or ‘fully met’ by it.”

Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772 (Fed. Cir. 1983); *see Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (quoting *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 781 (Fed. Cir. 1985)) (“Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.”). “[A]nticipation analysis [must] be conducted on a limitation by limitation basis, with specific fact findings for each contested limitation and satisfactory explanations for such findings.” *Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997). “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

ANALYSIS

The Examiner rejects claims 1-36 under 35 U.S.C. § 102(e) as being unpatentable over Krishnan. Appellants contend that Krishnan does not disclose, teach or suggest wirelessly transmitted address data associated with

a network-accessible device received by a client device and useable by the client device to access the network-accessible device through a network (App. Br. 9-14.) The Examiner, conversely, contends that Krishnan discloses each feature of Appellants' claims. We will reverse the Examiner's rejection of claims 1-36 for the reasons that follow.

Giving the broadest reasonable interpretation to Appellants' claims in light of the Specification, we find, as argued by Appellants, that each of the claims requires wirelessly transmitting (beaconing) or receiving address data associated with a network-accessible device to (in) a client device, the associated address data useable by the client device to access the network-accessible device (associated with the address data) through a network. (FF 1-2 and App. Br. 9-14.) In other words, "a device that wirelessly transmits its own address data to client devices so that the client devices can establish network links with that device." (App. Br. 10 (emphasis original).) For example, claim 21 recites "wirelessly beaconing address data associated with a particular device, the address data being configured for receipt by one or more client devices so that the one or more client devices can use the address data to establish an Internet link with the particular device for interacting with the particular device."

Krishnan describes an Internet appliance (e.g., a cell phone, office equipment, or a media delivery apparatus) that accesses other Internet-connected devices (e.g., a media server providing media content to an Internet site) through the Internet using the Internet address (URL) of the

device. The Internet appliance includes a wireless address beacon and a wireless address receiver for sending and receiving address data. (FF 7, 8, 10-12.) Krishnan also describes an Internet appliance remote operator that remotely controls the Internet appliance – wirelessly sending Internet addresses to and receiving Internet addresses from the appliance – allowing a user to access the Internet-connected devices or Internet sites. (FF 9.) Accordingly, Krishnan describes that office equipment, such as a printer, is network-accessible (Internet-accessible), and may be directed to access a network-connected device using a remote operator.

We disagree, however, with the Examiner’s findings that Krishnan discloses each feature of Appellants’ claims – specifically, that Krishnan discloses “a wireless transmitter for wirelessly transmitting associated address data for receipt by individual client devices, the address data being configured for use in accessing, via a network, a network-accessible device that wirelessly transmitted the associated address data.” (Ans. 4.) In particular, we disagree with the Examiner’s finding that Appellants’ claims do not require “a device that wirelessly transmits its own address data.” (Ans. 6.) Even in light of Appellants’ own description of typical prior art systems including client devices that can access network-accessible devices (printers, etc.) through a network (either through a hard-wired connection or wirelessly), and our recognition that it is well known to use portable client devices to wirelessly access the Internet and network-accessible devices such as servers (FF 4-6), Krishnan does not disclose, expressly or inherently,

a client device that links to a network-accessible device (such as a printer) through a network using wirelessly transmitted address data from the network-accessible device. Krishnan instead describes Internet accessible office equipment, cell phones, and portable computers that may be directed to access other Internet-connected devices using a remote operator.

CONCLUSION OF LAW

On the record before us, we find that Appellants establish that the Examiner erred in determining that Krishnan discloses each feature of Appellants' invention, in particular, wirelessly transmitting address data to a client device – the address data associated with a network-accessible device and useable by the client device to access the network-accessible device through a network.

DECISION

We reverse the Examiner's rejection of claims 1-36.

REVERSE

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